

**REMARKS**

**INTRODUCTION:**

In accordance with the foregoing, claim claims 18 and 21 have been amended. No new matter is being presented, and approval and entry of the foregoing amendments are respectfully requested. Claims 7-10, 15, 18-25, and 42-49 are under consideration. Reconsideration is requested.

**REJECTION UNDER 35 U.S.C. §112:**

In the Office Action at pages 2-3, the Examiner rejects claim 18 under 35 U.S.C. §112, second paragraph, as being indefinite. This rejection is respectfully traversed and reconsideration is requested.

Claim 18 has been amended as suggested by the Examiner and as would have been understood by one of ordinary skill in the art without narrowing the scope of the claim. As such, it is respectfully requested that the Examiner reconsider and withdraw the rejection.

**REJECTION UNDER 35 U.S.C. §103:**

**1. Rejection in view of Toyama et al. and Mortimer et al.**

In the Office Action at pages 3-4, the Examiner rejects claims 7-10 under 35 U.S.C. §103 in view of Toyama et al. (Japanese Patent Publication No. 07-295,998) and Mortimer et al. (U.S. Patent No. 6,091,930). The rejection is respectfully traversed and reconsideration is requested.

On page 4 of the Office Action, the Examiner admits that Toyama et al. does not suggest marking the updated portion and the non-updated portion so that they are distinguishable from each other. In order to cure this deficiency, the Examiner relies upon Mortimer et al. and asserts that one of ordinary skill in the art would have been motivated to make the combination since Mortimer et al. suggests, in col. 16, line 60 to col. 17, line 15, enabling the reader to distinguish the original data from the added or altered data.

By way of review, Mortimer et al. suggests an educational system in which a CITbook is modified by a professor for use in a particular class. If the professor makes any changes to the existing CITbook, any additions or deletions to the CITbook are marked so that the student can determine what portions are well accepted as opposed to those portions which are not well accepted. Further, once distributed, the additions or deletions can be reviewed and any markings removed if it is determined that the changes correspond to well accepted information. In this way, the subject matter is kept up to date while allowing the students to distinguish well

accepted text versus non-well accepted text. (Col. 6, lines 47-67, col. 7, lines 1-13, line 51 to col. 8, line 5 of Mortimer et al.) However, while suggested for use in the context of providing an educational textbook, Mortimer et al. does not suggest that the visual distinction between the altered text and the accepted text would have advantages in non-educational settings or in settings other than where there is a need to distinguish between well accepted and non well accepted facts.

In contrast, Toyama et al. teaches an electronic publications medium having commodity information which is updated and is displayed as shown in FIG. 6. (Paragraphs 0003-0004, 0025, 0026 of Toyama et al.). There is no suggestion that there is a need to differentiate the existing and updated commodity information retrieved from the disc to be displayed using different markings types as is done in Mortimer et al.

As a general matter, in order to establish a prima facie obviousness rejection, the Examiner needs to provide both the existence of individual elements corresponding to the recited limitations, and a motivation to combine the individual elements in order to create the recited invention. Both the individual elements and the motivation need to be shown to have existed in the prior art. Should the Examiner fail to provide evidence that either one of the individual elements or the motivation does not exist in the prior art, then the Examiner has not provided sufficient evidence to maintain a prima facie obviousness rejection of the claim. MPEP 2143.03. Thus, the burden is initially on the Examiner to provide evidence as to why one of ordinary skill in the art would have been motivated to combine the individual elements to create the recited invention, and to demonstrate that this evidence existed in the prior art. MPEP 2143.01.

As such, even assuming arguendo that Mortimer et al. suggests the features are set forth in the Office Action, there is no suggestion of a need to make new and old distinguishable in the context of commodity information stored on an electronic publication medium as described in Toyama et al. as would be required to meet the claimed invention of claim 7. Therefore, it is respectfully submitted that the combination does not disclose or suggest, among other features, that "during said displaying of the commodity catalog information, the commodity catalog information is marked so that an updated portion and a non-updated portion are distinguished from each other" as recited in claim 7.

Claims 8-10 are deemed patentable due at least to their depending from claim 7.

## 2. Rejection in view of Toyama et al. and Tognazzini

In the Office Action at pages 4-7, the Examiner rejects claims 15, 18, and 22 under 35 U.S.C. §103 in view of Toyama et al. and Tognazzini (European Patent Publication No. 0 817

181). The rejection is respectfully traversed and reconsideration is requested.

On page 5 of the Office Action, the Examiner admits that Toyama et al. does not disclose a writable area to which information is written once and is thereafter a read only area. In order to cure this deficiency, the Examiner relies upon Tognazzini. By way of review, Tognazzini discloses a hybrid disk 100 having a read only area 101 and a read/write area 102. However, as seemingly acknowledged by the Examiner on page 5 of the Office Action, Tognazzini teaches that the read/write area 102 allows for multiple writes to the same area. As such, it is respectfully submitted that, even assuming arguendo that the combination is proper, the combination does not disclose that "said writeable area comprises an area to which information is written once, and is thereafter a read only area" as recited in claim 15.

In order to cure this deficiency, the Examiner asserts that the existence of CD-R and DVD-R is known, and that the use of CD-R and DVD-R would alleviate a problem in that original information cannot be changed and additional information cannot be added to read only optical disks. However, even assuming arguendo that the Examiner is correct as to the existence of CD-R and DVD-R, it is respectfully submitted that there remains insufficient evidence of a motivation to use a CD-R or a DVD-R instead of or in addition to a rewritable disk area 102 as suggested in Tognazzini.

Specifically, Tognazzini suggests using the rewritable area 102 to record supplemental information in addition to the original information, which is written in the read only area 101. (Col. 2, lines 22-26 of Tognazzini). By having the area 102 be write once as in a CD-R or DVD-R as suggested by the Examiner, the ability to record the supplemental information would be frustrated since the amount of supplemental information would be limited since the space used to record the data decreases each time supplemental information is recorded. In essence, should one version of the supplemental information be recorded on the area 102, the amount of usable area 102 would be reduced by the size of the one version. In contrast, by allowing erasing and overwriting as suggested in Tognazzini, the usable portion of the area 102 is not reduced when supplemental information is written to the area 102. As such, by substituting a CD-R or DVD-R for the rewritable area 102 as suggested by the Examiner, the recordable amount of supplemental information would be reduced, which is contrary to the purpose of Tognazzini.

In maintaining a prima facie obviousness rejection, the Examiner is required to evaluate the record as a whole, and to account for contrary teachings existing in the record. In re Young, 18 USPQ2d 1089 (Fed. Cir. 1991) cited by MPEP 2143.01. Further, such combinations cannot render the combine product to be unsatisfactory for its intended purpose. In re Gordon, 221

USPQ 1125 (Fed. Cir. 1984) cited by MPEP 2143.01. It is respectfully submitted that the substitution of a CD-R or DVD-R for the rewritable area 102 would reduce the effectiveness of the solution proposed in Tognazzini such that one of ordinary skill in the art would not have been motivated to reduce the useable area 102 over time in the manner suggested in the Office Action.

As such, it is respectfully submitted that there is insufficient evidence of record as to why one of ordinary skill in the art would have the area 102 be non-rewritable as is required to maintain a prima facie obviousness rejection under 35 U.S.C. §103 of claim 15 in view of the above combination.

For at least similar reasons, it is respectfully submitted that claim 18 is deemed patentable over the asserted combination.

Claim 22 is deemed patentable due at least to its depending from claim 18.

**3. Rejection in view of Toyama et al., Tognazzini, and Uranaka**

In the Office Action at pages 7-8, the Examiner rejects claims 19, 20, and 23 under 35 U.S.C. §103 in view of Toyama et al., Tognazzini, and Uranaka (U.S. Patent No. 5,937,158). The rejection is respectfully traversed and reconsideration is requested.

Even assuming arguendo that Uranaka teaches the features as set forth in the Office Action and the combination is otherwise proper, the Examiner does not rely upon Uranaka as curing the above noted deficiencies of the combination of Toyama et al. and Tognazzini as applied to claim 18, from which claims 19, 20, and 23 depend. As such, it is respectfully submitted that the combination does not disclose or suggest the features of claims 19, 20, and 23 due at least to the combination not disclosing or suggesting the features of claim 18.

**4. Rejection in view of Toyama et al. and Uranaka**

In the Office Action at pages 8-9, the Examiner rejects claims 21, 24, and 25 under 35 U.S.C. §103 in view of Toyama et al. and Uranaka. The rejection is respectfully traversed and reconsideration is requested.

As similarly noted above in regard to the rejection of claim 7 and as acknowledged by the Examiner on page 4 of the Office Action, Toyama et al. does not suggest marking the updated portion and the non-updated portion so that the portions are distinguishable from each other. As such, since Uranaka is not relied upon as disclosing such a feature, it is respectfully submitted that the combination does not disclose or suggest "displaying both the existing and updated commodity catalog information such that the updated commodity catalog information is marked to be distinguishable from the existing commodity catalog information" as recited in claim 21.

Claims 24 and 25 are deemed patentable due at least to their depending from claim 21.

**5. Rejection in view of Toyama et al. and Yoshimoto et al.**

In the Office Action at pages 9-11, the Examiner rejects claims 42-49 under 35 U.S.C. §103 in view of Toyama et al. and Yoshimoto et al. (U.S. Patent No. 5,953,309). The rejection is respectfully traversed and reconsideration is requested.

On page 10 of the Office Action, the Examiner asserts that Yoshimoto et al. suggests using an optical disk having multiple zones that can be set to be write once and rewritable since this would enable a user to place different types of areas on a single disc which would best suit an intended application as set forth in col. 4, lines 20-25. However, as also noted above in relation to the rejection of claims 15, 18, and 22, even assuming arguendo that Yoshimoto et al. teaches the ability to have a disc with multiple zones having different recording possibilities, there is no suggestion as to why the disk of Toyama et al. should include both a write once area and a rewritable area in addition to a read only area, or that the intended application of Toyama et al. would benefit from such different writable areas on a single disk. As such, even assuming arguendo that the Examiner has shown that a capability existed in the prior art to provide such areas on a single disk, there remains no evidence of a motivation as to why such areas would be used in the disk of Toyama et al.

As such, it is respectfully submitted that there is insufficient evidence of record as to why one of ordinary skill in the art would have been motivated to combine Toyama et al. and Yoshimoto et al. to create the invention of claim 42 as is required to maintain a prima facie rejection of claim 42 under 35 U.S.C. §103.

Claims 43-49 are deemed patentable due at least to their depending from claim 42.

**CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, it is respectfully submitted that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

**SERIAL NO. 09/809,631**

**DOCKET NO. 1293.1184**

If there are any additional fees associated with the filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI LLP

By: 

James G. McEwen  
Registration No. 41,983

1400 Eye Street, NW  
Suite 300  
Washington, D.C. 20005  
Telephone: (202) 216-9505  
Facsimile: (202) 216-9510

Date: DEC 13, 2004